

**Remarks**

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

**Substance of Interview**

Applicants' attorney expresses his appreciation for the courtesy of a telephone interview granted to him by Examiner Boykin on January 13, 2009.

Toward the beginning of the interview, Applicants' attorney proposed certain claim amendments. The amendments will be discussed below.

The Examiner indicated that the amendments proposed during the interview will be entered, and appear to overcome all of the rejections under 35 U.S.C. §112, 35 U.S.C. §102(b) and 35 U.S.C. §103(a).

**Claim Amendments**

Claim 1 has been amended exactly as discussed during the interview. That is, this claim has been amended to incorporate the feature of claim 7, as a result of which claim 7 has been cancelled. Amended claim 1 further recites that the proton sources include free  $\alpha$ -hydroxycarboxylic acid and dimer thereof, which is based on the disclosure at page 10, line 21 and page 11, line 1 of the specification.

**Claim Rejections**

The rejection of claims 1-12 under the first paragraph of 35 U.S.C. §112 is respectfully traversed.

As discussed during the interview, this rejection appears to be a new rejection which was not necessitated by Applicants' previous claim amendments, and therefore, the current Office Action should not have constituted a final rejection. The Examiner indicated during the interview that the present claim amendments would be entered even though they are being presented after a final rejection.

The Examiner refers to the disclosure of the specification that the total proton concentration of the impurities contained in the cyclic ester is preferably 0.01 to 0.5 mol%. Initially, Applicants point out that this is a **preferred** range, as apparent from page 13, lines 17-18. Furthermore, this range refers to the impurities in the starting cyclic ester without taking account of the amounts of the water added to the polymerization system, now accounted for by the range of above 0.09 mol% and below 2.0 mol% of proton sources set forth in amended claim 1 above.

The rejection under 35 U.S.C. §112 also refers to the carboxyl group capping agents. However, the capping agents employed in the present invention are not part of the inventive concept. Accordingly, Applicants respectfully submit that they should not be required to restrict the scope of the capping agents.

During the interview, the Examiner appeared to agree that the rejection under 35 U.S.C. §112 would be withdrawn.

The patentability of the presently claimed invention over the disclosures of the references relied upon by the Examiner in rejecting the claims will be apparent upon consideration of the following remarks.

Thus, the rejection of claims 1, 2, 4-8 and 9 under 35 U.S.C. §102(b) as being anticipated by EP 1 048 683, as well as the rejection of the claims under 35 U.S.C. §102(b) as being anticipated by EP 0 299 730, are respectfully traversed.

The present invention is directed to a process for producing an aliphatic polyester of a **controlled molecular weight** by ring-opening polymerization of a cyclic polyester containing **water in excess of 80 ppm while controlling a total concentration of proton-sources including water and proton-source impurities** in the cyclic ester **so as to provide a desired weight-**

**average molecular weight of resultant aliphatic polyester by varying the content of the water in the cyclic ester**, and compounding the resultant aliphatic polyester with a carboxyl group-capping agent. The positive use of water at a large level negated heretofore for molecular weight control of the resultant aliphatic polyester and obviation of adverse effects thereof by compounding of the resultant polyester with a carboxyl group-capping agent, are the principal characteristic of the present invention. For accurate molecular weight control, the contribution of proton-source impurities, such as glycolide acid (GA) and glycolic acid dimer (GA2), is also taken into account as described at page 23 of the specification.

In short, the claimed process can be regarded as a method of controlling the molecular weight of the aliphatic polyester product by positively utilizing water as a molecular weight regulator, which has not been contemplated in the conventional processes as disclosed in the cited references.

During the interview, the Examiner appeared to agree that the rejections for anticipation based on the EP '683 and EP '730 references would be withdrawn.

The rejection of claim 2 under 35 U.S.C. §103(a) as being unpatentable over either EP '683 or EP '730 in view of USP 5,885,709 or USP 2,937,164 is respectfully traversed.

The comments set forth above concerning the EP '683 and EP '730 references are equally applicable to this rejection.

Claim 2 is directly dependent on claim 1, which is the only independent claim. Claim 1 is patentable over the EP '683 and EP '730 references for the reasons set forth above. The US '709 and US '164 references are applied only for a teaching of carboxyl group-capping agents. But even if the references were combined, the result of such combination would still not suggest the subject matter of claim 2, considering that this claim is directly dependent on claim 1.

Similar considerations apply to the rejection of claim 3 under 35 U.S.C. §103(a) as being unpatentable over EP '683 or EP '730 in view of JP 57-094019, which is respectfully traversed.

That is, claim 3 is directly dependent on claim 1, which is patentable over EP '683 and EP '730 for the reasons set forth above. Therefore, even if the references were combined, the

result of such combination would still not suggest the subject matter of claim 3, considering that this claim is directly dependent on claim 1.

During the interview, the Examiner appeared to agree that the rejections under 35 U.S.C. §103(a) would be withdrawn.

In response to the provisional obviousness-type double patenting rejection of claims 1-12 as being unpatentable over the claims of Serial No. 10/577,379, Applicants are submitting herewith a Terminal Disclaimer, which overcomes this rejection.

Therefore, in view of the foregoing amendments and remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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